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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,075	09/22/2004	Raoul Donath	008932-1004-999	1247

51832 7590 12/29/2006  
JONES DAY  
222 EAST 41ST STREET  
NEW YORK, NY 10017-6702

EXAMINER
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WOODALL, NICHOLAS W

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/509,075

Applicant(s)

DONATH, RAOUL

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13<sup>th</sup> October, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to applicant's amendment received on October 13<sup>th</sup>, 2006.

#### ***Specification***

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The abstract of the disclosure is objected to because the abstract exceeds the limit of 150 words in length. Correction is required. See MPEP § 608.01(b).

#### ***Drawings***

4. The drawings were received on October 13<sup>th</sup>, 2006. These drawings are acceptable.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffler-Wachter (U.S. Patent 6,402,752) in view of Katz (U.S. Patent 5,989,254).

Regarding claim 1, Schaffler-Wachter (hereinafter referenced as Schaffler) discloses a device comprising a connection element, a sealing cap, and a tensioning means. The connection element includes a central axis, an external surface, and upper end, a lower end, a cavity extending coaxially along the central axis from the upper end to the lower end with a reduced portion at the lower end forming at least one shoulder therein, and a channel passing through the connecting element transversely to the central axis. The sealing cap includes a front end, a rear end, a second cavity opening at the front end, and a second channel extending transversely to the central axis and opening towards the front end of the sealing cap. The external surface of the connection element and the internal surface of the second cavity formed in the sealing cap contain complementary arresting means (see Figure 1 below). Regarding claim 2, Schaffler discloses a device wherein the arresting means are arranged orthogonal to the central axis on the periphery of the connection element and on the periphery of the second cavity in the sealing cap. Regarding claim 3, Schaffler discloses a device wherein the arresting means includes a plurality of bulges formed on the external surface of the

connection element and a plurality of complementary depressions formed in the second cavity of the sealing cap. There are two bulges (reference number 12) and two slots (reference number 13), which are therefore a plurality of each that correspond to each other. Regarding claim 4, Schaffler discloses a device wherein the shoulder has a level-bearing surface of a circular-ring shape. Regarding claim 5, Schaffler discloses a device wherein the sealing cap further includes two slots arranged orthogonal to the second channel, the slots extending from the front end of the sealing cap. Regarding claim 6, Schaffler discloses a device further comprising a bone fixation means having a central axis, a front segment, and an axially adjoining rear segment, wherein the rear segment has a cylindrical form and the front segment extends through the lower end of the connection element. Regarding claim 7, Schaffler discloses a device wherein the bone fixation means is a pedicle screw with a screw shaft having an external thread and a screw head at an end thereof. Regarding claim 8, Schaffler discloses a device wherein the tensioning means comprises a setscrew. Regarding claims 1 and 9, Schaffler disclose the invention as claimed except for the device comprising a securing means (claim 1), wherein the securing means includes a pin and hole configuration (claim 9). Katz teaches a device comprising a securing means that includes a pin and hole configuration in order to restrain the connecting member to the pedicle screw (column 2 lines 61-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Schaffler with a securing means in view of Katz in order to restrain the connecting member to the pedicle screw.

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7. Claims 1-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffler-Wachter (U.S. Patent 6,402,752) in view of Nichols (U.S. Patent 6,090,111).

Regarding claims 1-8 and 10, Schaffler-Wachter (hereinafter referenced as Schaffler) discloses the invention as claimed except for the device comprising a securing means (claim 1), wherein the securing means includes a snap-ring and groove configuration (claim 10). Nichols teaches a device comprising a securing means that includes a snap-ring and groove configuration in order to retain the fastener (column 4 lines 5-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Schaffler with a securing means in view of Nichols in order to retain the fastener.

### ***Response to Arguments***

8. Applicant's arguments, see page 10 lines 4-7, filed October 13<sup>th</sup>, 2006, with respect to the rejection(s) of claim(s) 3 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art. U.S. Patent 5,989,254 by Katz teaches of a device that uses a securing means with a pin and hole configuration to retain the fastener with a connection element. When used in combination with the base reference of Schaffler-Wachter as discussed above the combination reads upon claims 1-9. U.S. Patent 6,090,111 by Nichols teaches a device that uses a securing means with a snap-ring and groove configuration. When used in

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combination with the base reference of Schaffler-Wachter as discussed above the combination reads upon claims 1-8 and 10.

9. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. The reference of Schaffler-Wachter as discussed in the previous office action discloses an arresting means comprising a plurality of bulges (the two ridges disclosed as reference number 12 in the reference) and a plurality of complimentary depressions (the two slots disclosed as reference number 13) in the sealing cap. The examiner believes this meets the structural limitations set forth in claim 3.

### ***Conclusion***

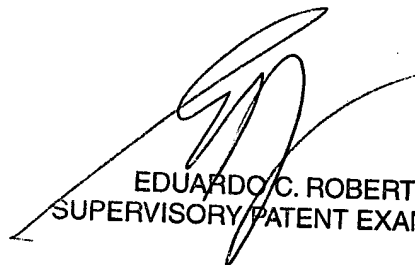
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Pto-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER